

Oral Hearing:
July 2, 1998

Paper No. 21
GDH/gdh

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB APRIL 7, 99
U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

CSC Brands, Inc.
v.
Jalil Tehranchi and Kambiz Tehranchi

Opposition No. 105,165 to application Serial No. 75/027,430
filed on December 4, 1995

Roberta Jacobs-Meadway and Karol A. Kepchar of Panitch Schwarze
Jacobs & Nadel, P.C. for CSC Brands, Inc.

Jay S. Kopelowitz of Kopelowitz & Associates for Jalil Tehranchi
and Kambiz Tehranchi.

Before Cissel, Hohein and Walters, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

An application has been filed by Jalil Tehranchi and
Kambiz Tehranchi¹ to register the mark "G8" for "bread, breakfast

¹ Throughout this opinion, the above individuals will be collectively referred to in the singular as "applicant".

cereals, granola-based snack bars, muffins, cookies, wheat-based snack foods in bar form, [and] crackers".²

Registration has been opposed by **CSC Brands, Inc.** on the ground that, since prior to the filing date of applicant's application, opposer and its predecessors in interest have continuously used the mark "V8" for beverages, namely, "vegetable juices"; that opposer is the owner of a registration for the mark "V8," in the form reproduced below,

for "vegetable juices";³ and that applicant's mark, when used in connection with its goods, so resembles opposer's mark as to be likely to cause confusion, mistake or deception.

Applicant, in its answer, has admitted that it has not used its mark prior to the filing date of its application, but has otherwise denied the salient allegations of the opposition.⁴

² Ser. No. 75/027,430, filed on December 4, 1995, which alleges a bona fide intention to use the mark in commerce.

³ Reg. No. 507,653, issued on March 15, 1949, which sets forth dates of first use of July 17, 1937; second renewal.

⁴ While applicant additionally asserted, as affirmative defenses, that the opposition is barred by the doctrines of "laches," "estoppel," "acquiescence" and "unclean hands" and that opposer "is improperly attempting to exclude others from using marks for goods and/or services that are not closely related to the goods that Opposer markets and sells," such defenses not only have not been properly pleaded, in that the facts constituting each defense have not been alleged, but in any event the defenses were neither tried nor raised in the briefs. Accordingly, no further consideration will be given to applicant's putative affirmative defenses.

The record includes the pleadings; the file of the opposed application; and, as part of opposer's case-in-chief, the testimony, with exhibits, of Andrew J. Rosenbach, vice-president for beverage products of opposer's corporate parent, Campbell Soup Company.⁵ As the rest of its case-in-chief, opposer has submitted notices of reliance upon the following: (a) certified copies of its pleaded registration and four other registrations, involving the marks and goods which are set forth below, showing that the registrations are subsisting and owned by opposer:⁶

(1) the mark "V8" and design, as depicted below,

for a "combination of eight vegetable juices";⁷

(2) the mark "V8" and vegetables design, as illustrated below,

⁵ The stipulation to take such deposition on August 27, 1997 is approved.

⁶ In accordance with Fed. R. Civ. P. 15(b), which is made applicable by Trademark Rule 2.116(a), the pleadings are hereby deemed to be amended to include the four additional registrations relied upon by opposer.

⁷ Reg. No. 354,003, issued on January 25, 1938, which sets forth dates of first use of July 17, 1937; third renewal.

for "canned mixed vegetable juices which may be served cold or used as a soup preparation";⁸

(3) the mark "V8" for "vegetable juices";⁹ and

(4) the mark "V8 PICANTE" and design, as shown below,

for "vegetable juice";¹⁰

(b) plain copies of a number of third-party registrations;¹¹ (c) applicant's responses to certain of opposer's interrogatories; (d) various articles from printed publications of general

⁸ Reg. No. 424,632, issued on October 15, 1946, which sets forth dates of first use of July 17, 1937 and disclaims "THE REPRESENTATION OF THE VEGETABLES"; second renewal.

⁹ Reg. No. 1,285,492, issued on July 10, 1984, which sets forth dates of first use of July 17, 1937; combined affidavit §§8 and 15.

¹⁰ Reg. No. 1,846,906, issued on July 26, 1994, which sets forth dates of first use of August 3, 1993 and disclaims "PICANTE". According to the registration:

THE MARK "V8" APPEARS IN BLACK AND THE WORD "PICANTE" APPEARS IN YELLOW ON A BACKGROUND DESIGN LINED FOR THE COLORS PURPLE, YELLOW, ORANGE, GREEN AND PINK. THE BACKGROUND DESIGN RESEMBLES A MEXICAN SERAPE.

¹¹ Opposer states that it relies upon such registrations "to show that it is common for companies to register the same marks for bakery products and for juices."

circulation, including those "available on the Nexis database, and[/]or the Internet";¹² and (e) applicant's responses to certain of opposer's requests for admission.

Applicant, as its case-in-chief, has submitted a notice of reliance upon copies of several third-party registrations,¹³ but it did not take any testimony. Opposer, in rebuttal, has presented the testimony, with exhibits, of Lucetta M. McHugh, a senior intellectual property specialist for the Campbell Soup Company. Briefs have been filed, and an oral hearing, attended only by counsel for opposer, was held.

Opposer's priority of use of the marks upon which it relies is not in issue inasmuch as the certified copies of the registrations therefor show that such are subsisting and owned by

¹² Opposer indicates that "such materials are introduced to show recognition of the V8 mark ... and the availability of information on sales and advertising and line extensions for the V8 product." Although the articles from the "NEXIS" database and all but one of those from the Internet websites are simply copies of articles which have appeared in printed publications, and thus are plainly within the purview of Trademark Rule 2.122(e), which permits the introduction by means of a notice of reliance of "[p]rinted publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public," whether the rule covers information which is available solely in electronic form through the Internet, such as the article from the website of the American Heart Association, is questionable. In any event, inasmuch as applicant, in its brief, has treated opposer's evidence as forming part of the record, the latter article is deemed to be of record pursuant to Trademark Rule 2.123(b), which provides in relevant part that "the facts in the case of any party may be stipulated." However, it is pointed out that to the extent which opposer seeks to rely upon such articles for the truth of the statements therein and not simply for what they show on their face, the articles are inadmissible as hearsay and have not been considered for such purpose. See Fed. R. Evid. 801 and 802; and TBMP §708.

¹³ Applicant maintains that such registrations "show that there are many other registrations [for marks] comprising a constant [sic, should be consonant] followed by a numeral and that some of these

opposer. See King Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). The record, in any event, establishes that applicant has not commenced use of its "G8" mark and that opposer has priority since it has used its "V8" marks, including its "V8 PICANTE" mark, prior to the filing date of the opposed application, which is the earliest upon which applicant can rely in this proceeding.¹⁴ The only real issue to be determined, therefore, is whether applicant's "G8" mark, when used in connection with bread, breakfast cereals, granola-based snack bars, muffins, cookies, wheat-based snack foods in bar form and crackers, so resembles opposer's various "V8" marks for vegetable juices that confusion is likely as to the origin or affiliation of the parties' respective goods.

According to the record, opposer is a "wholly owned indirect subsidiary" of the Campbell Soup Company, which is "a Fortune 500 ... manufacturer of many food products" and the actual user of the registered "V8" marks owned and maintained by opposer. (McHugh dep. at 6-7.) The Campbell Soup Company presently markets three categories of beverages in the United States: "the Campbell tomato juice line; the V8 vegetable juice line; and a new line of V8 Splash, which is ... [a] fruit juice blend". (Rosenbach dep. at 6.) It also produces and sells various baked products, including its "Pepperidge Farm" brand of

registrations [are for goods which] are sold in stores that also carry Opposer's vegetable juice products."

¹⁴ See, e.g., Lone Star Manufacturing Co., Inc. v. Bill Beasley, Inc., 498 F.2d 906, 182 USPQ 368, 369 (CCPA 1974) and Columbia Steel Tank Co. v. Union Tank & Supply Co., 277 F.2d 192, 125 USPQ 406, 407 (CCPA 1960).

bread, crackers and cookies and its "Goldfish" brand of crackers, cookies and snacks, and has done so for a number of years.

The "V8" line of beverages includes, in particular, the original formulation, consisting of a blend of eight different vegetable juices, which has been sold under the "V8" mark "for approximately 50 years." (Id. at 17.) Other varieties of "V8" vegetable juices are a "Lightly Tangy V8" blend, which "has been available for a little under ten years," a "V8 Picante Mild Flavor" variation, which has been offered for sale for "[a]bout five years," a "V8 Healthy Request" version, which has been available for about three months and thus is the "newest offering in the V8 line," a "Spicy Hot V8" flavor, a "V8 Plus" vitamin fortified version, and a "Low Sodium V8" formulation.¹⁵ (Id. at 18 and 19.)

"V8" brand products were extended in the Spring of 1997 to a line of fruit-carrot juice beverages, available in tropical fruit, citrus fruit and strawberry-kiwi flavors, which are sold under the "V8 Splash" mark. Research projects concerning further extensions of the "V8" brand to "a V8 vegetable cracker line" and, as recently as about February 1995, "a snack pack that would be a combination of Pepperidge Farm crackers with a V8 beverage product" have also been done. (Id. at 33.)

In addition, the Campbell Soup Company does "a lot" of co-marketing of "V8" beverages with its other products, such as

¹⁵ As to the latter three varieties, Mr. Rosenbach testified that while such are available, he did not know how long they have been offered.

"Goldfish" crackers and "Campbell's" soups, and does co-branding with products of other companies. As an example of the latter, Mr. Rosenbach testified that:

In January [1997,] we did a major promotion with Kellogg's joining our V8 brand with their Complete brand [bran] flakes cereal line. This included freestanding inserts, using the back panel of their cereal, as well as promotions on our product to promote the two products.

(Id. at 34-35.)

According to Mr. Rosenbach, "'V8' is a very famous mark and one that is well recognized." (Id. at 23.) Independently conducted market research in 1997, he noted, shows "nearly 100% awareness of the V8 brand in the United States." (Id. at 31.) Mr. Rosenbach also indicated that he is not familiar with any other product, sold through the supermarket, in which the brand name consists of a single letter combined with the number "8".

Currently, in terms of retail sales, "the "V8" brand has about a 55% share of the vegetable juice category." (Id. at 36.) Over the past five years, annual sales of "V8" products in the United States have been "approximately \$250 million." (Id. at 37.) As far as Mr. Rosenbach is aware, there has not been any time during the past 50 years in which "V8" products have not been sold. With respect to their manner of use, the "V8" marks appear on product labels, shipping cases, shipping pallets and point-of-sale materials, such as shelf talkers and display cards.

For at least the past 20 years, the primary means used to by Campbell Soup Company to advertise "V8" brand products has been national television ads. One of its "more noteworthy"

television advertising campaigns featured the famous "tag line of, 'Wow, I could have had a V8'," while its "most recent advertising campaign is focused on living life on all eight cylinders with V8." (Id. at 38.) Other methods utilized to promote "V8" products include radio, magazine, newspaper and in-store advertising. In particular, "V8" products have been advertised in women's magazines such as Good Housekeeping, in senior citizens' magazines such as Modern Maturity and in trade publications such as Progressive Grocer. For the past five years, the advertising budget for the "V8" brand "has been approximately \$10 million per year." (Id. at 41.)

Of the other promotional vehicles used by Campbell Soup Company to support the "V8" brand, including advertising on the Internet at its webpage, "the most popular" are "the Sunday freestanding insert coupon programs," which are run in newspapers from four to six times a year at an annual cost of "approximately \$750,000". (Id. at 41-42.) Coupons are also distributed to consumers using point-of-sale and direct mail advertising. In addition, Campbell Soup Company does cooperative advertising for its "V8" products, spending "approximately \$20 million a year" to provide "ad slicks and suggested advertising layouts". (Id. at 49.)

While, according to Mr. Rosenbach, the trade channels for "V8" products are "virtually any place that you can buy a food and beverage product in the United States," he indicated that "our primary distribution channel is supermarkets." (Id. at 52.) Other important trade channels "include club stores like

Sam's and Price Costco; convenience stores like 7-Eleven and Wawa; mass merchandisers like K Mart and Target; drug stores like Walgreen's and CVS; [and] military bases and commissaries." (Id. at 52-53.) Mr. Rosenbach also testified that Campbell Soup Company sells "V8" products "through our food service channels," which "include everything from vending machines to schools to restaurants." (Id. at 52.) As the list of outlets makes plain, "V8" products are "bought and consumed by a broad composite of the population from young to old, across various income and ethnic groups." (Id. at 54.) The retail price of a "V8" product, according to Mr. Rosenbach, is "most likely in the range of 50 cents to \$3.50," depending upon the package size. (Id. at 55.)

Mr. Rosenbach further noted that he is familiar with instances where a company uses the same mark in connection with both beverages and baked goods, naming as examples the house marks "Starbucks" and "Dunkin' Donuts". One of opposer's notices of reliance, for the most part, likewise shows a number of third-party registrations for house marks which, in each instance, are registered for both beverages and baked goods. Several of such registrations in fact cover vegetable juice or tomato juice, on the one hand, and bread, rolls and/or cookies, on the other.

Finally, the record shows that Campbell Soup Company has actively policed opposer's "V8" marks and the advertising slogan, "Wow, I could have had a V8". In particular, a third party was allowed to register the mark "B8" for "birdseed," but only after it entered into a settlement agreement with opposer

and Campbell Soup Company which prohibited use of such mark for any food or beverage for human consumption. As a result, in part, of such enforcement efforts, Ms. McHugh expressed the opinion that the "V8" mark "has built up quite a large following of consumers and it is well recognized throughout the country." (McHugh dep. at 17.)

The only information of record concerning applicant and its activities is contained in applicant's responses to certain of opposer's discovery requests. The responses indicate that while applicant intends to use the "G8" mark for "cereal, energy bars, and bread" and to sell its "G8" products "[m]ostly [in] supermarkets and wholesale food clubs," applicant has yet to use such mark in the United States in connection with any food product. (Responses to Interrogatory Nos. 1 and 10.) In this regard, applicant has not made any advertising expenditures, budgeted any funds for introducing any products, set any sales projections, conducted any consumer surveys, hired any advertising agencies or engaged any public relations firms to promote its contemplated "G8" brand products.

In addition, applicant admits that, at the time the involved application was filed, applicant was aware of opposer's use of the "V8" mark in connection with vegetable juices and that, prior to such filing, a trademark investigation was conducted. Applicant further admits that the "V8" mark has no descriptive significance as applied to vegetable juices and that, similarly, its "G8" mark has no descriptive significance as applied to any of the products specified in the involved

application, although it does suggest that applicant's products contain eight types of grains. Applicant also admits that its intends to sell its "G8" brand goods to the general public through such retail outlets for food products as grocery stores, convenience stores, general merchandise stores and discount shopping clubs.

Although applicant introduced copies of five third-party registrations, including a registration for the mark "B8" for "birdseed," none is for goods which are even arguably related to vegetable juice products.¹⁶ Furthermore, applicant indicated that it is not aware of any third-party use of a mark consisting of a single consonant followed by the number "8" for food or beverage products.

Turning to the issue of likelihood of confusion, we find upon consideration of the pertinent factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973), that confusion as to source or affiliation is likely to occur. To begin with, we agree with opposer that, as indicated in its initial brief, the similarities in sound and appearance between several of its "V8" marks and applicant's "G8" mark "are self-evident." Opposer, in particular, accurately points out in this regard that:

Each mark is composed of two syllables. The syllables of each mark are composed of a

¹⁶ The other registrations pertain to the marks "B8" for stapling machines, "V6" and design for medicated and non-medicated chewing gum, "V8" and design for thermometers, and a highly stylized "D8" for digital magnetic recorders and/or players for digital data, unrecorded magnetic tapes and floppy discs.

single capital letter, followed by the number "8". Each capital letter incorporates the long "E" vowel sound. Neither mark uses punctuation to separate the single capital letter from the numeral. The second syllable of each mark is the number "8" and is therefore identical, both when seen and when spoken.

In comparison with applicant's "G8" mark, the same observations are likewise true with respect to the "V8" element in both opposer's "V8" and vegetables design mark and its "V8 PICANTE" mark, given the prominence in which such element is displayed in those marks and the descriptiveness of the term "PICANTE".

Furthermore, in terms of connotation and overall commercial impression, opposer's "V8" marks and applicant's "G8" mark are substantially similar inasmuch as the letter "V," as opposer notes in its initial brief, "suggests an element of the product (vegetables)," while the letter "G," as applicant has admitted, suggests the presence of grain-based products. In each of the marks, moreover, the numeral "8" refers to the number of different kinds of vegetable juices or types of grains respectively present in the parties' goods. In view thereof, and in light of the appreciable similarities in sound and appearance which have previously been mentioned, the respective marks engender substantially the same overall commercial impression when considered in their entirety. Consequently, if such marks were to be used in connection with the same or closely related food products, confusion as to the source or sponsorship thereof would be likely to occur.

The record, in addition, is sufficient to establish that opposer's "V8" mark is a famous mark for vegetable juices. As opposer, quoting from *Kenner Parker Toys Inc. v. Rose Art Industries Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992), *cert. denied*, 506 U.S. 862, 113 S.Ct. 181 (1992), stresses in its initial brief:

Where the prior mark is ... famous, the mark's renown becomes the primary *du Pont* factor in the likelihood of confusion assessment: "The [...] fame of the prior mark [...] plays a dominant role in cases featuring a famous or strong mark. Famous or strong marks enjoy a wide latitude of legal protection."

Here, the record shows, opposer's "V8" mark has been continuously used in connection with vegetable juices for at least 50 years; there is nearly 100% awareness of such brand among consumers in the United States; the mark has been actively policed; and there is no other product sold through supermarkets in which the brand name thereof consists of a single letter combined with the number "8". Moreover, the "V8" brand, in terms of retail sales, is currently the top seller in its product category, commanding about a 55% share of the vegetable juice market. Annual sales of "V8" brand products in the United States, over the past five years, have amounted, furthermore, to approximately \$250 million and advertising expenditures therefor, at a rate of about \$10 million yearly, have totaled in the neighborhood of \$50 million during the same period. "V8" brand products, in addition to principally being nationally advertised on television with such noteworthy ad campaigns as the one featuring the tag line of

"Wow, I could have had a V8," have been promoted through radio, magazine, newspaper, in-store and direct-mail advertising. In view thereof, and inasmuch as "V8" brand vegetable juices are available virtually anywhere that food and beverage products are sold, there is no doubt that such mark is famous for vegetable juices and therefore merits a wide latitude of protection from imitators.. See, e.g., *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992).

Given the substantial similarities, as previously noted, in the parties' marks and the long-standing public recognition and fame of opposer's "V8" marks for vegetable juices, confusion is likely to occur inasmuch applicant's "G8" goods would be considered by ordinary consumers to be closely related to the vegetable juice products sold under opposer's "V8" marks. While applicant argues in its brief that "[s]taple foods such as bakery products are vastly different than light beverages such as juices," the record demonstrates that not only are the respective products sold or offered for sale to the general public in the same channels of trade, including supermarkets, grocery stores, convenience stores, mass merchandisers and discount shopping clubs, but at least several third parties have, in each instance, adopted and registered the same mark for baked items, such as bread, rolls and/or cookies, as well as for vegetable or tomato juices. Although such registrations are admittedly not evidence that the marks shown therein are in use or that consumers are familiar with them, they nevertheless have some probative value to the extent that they serve to suggest

that the goods listed therein are of a kind which may emanate from a single source. See, e.g., In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1785-86 (TTAB 1993) and In re Mucky Duck Mustard Co. Inc., 6 USPQ2d 1467, 1470 (TTAB 1988) at n. 6.

Moreover, not only does opposer's parent, Campbell Soup Company, make and sell, albeit under other marks, such baked products as bread, crackers, cookies and snacks in addition to the vegetable juice products which it markets under opposer's "V8" marks, but it has done considerable co-marketing of "V8" beverages with, for example, its "Goldfish" crackers as well as co-branding of such beverages with products of other companies, including a recent promotion with Kellogg's "Complete" bran flakes cereal. Furthermore, to state the obvious, vegetable juices, like other beverages, are complementary food products to applicant's bread, breakfast cereals, granola-based snack bars, muffins, cookies, wheat-based snack foods in bar form and crackers due to the fact that they are often consumed together at the same meal or as a snack.

Consumers, therefore, would clearly regard the parties' goods as closely related products. In view thereof, and given the often hurried environment in which shopping occurs and the relatively inexpensive nature of the parties' goods, ordinary purchasers could reasonably believe that applicant's bread, breakfast cereals, grain-based snack bars, muffins, cookies and crackers, if sold under the "G8" mark, emanate from or are sponsored by the same source which markets the vegetable juices sold under opposer's famous "V8" marks. Indeed, even if

consumers were to notice the differences in the respective marks, they would still be justified in assuming, as would be likely, that the producer of "V8" vegetable juice products had expanded its offerings to a new but closely related "G8" line of baked products, especially since there is no evidence in this record of any third-party use for food products of marks which consist of a consonant and the numeral "8". The fame of the "V8" mark for vegetable juices would serve, in particular, to magnify the substantial overall similarities in sound, appearance, connotation and commercial impression between such mark and applicant's "G8" mark. See Kenner Parker Toys Inc. v. Rose Art Industries Inc., supra at 1458.

Accordingly, we conclude that consumers who are familiar with opposer's "V8" marks for vegetable juices would be likely to believe, upon encountering applicant's substantially similar "G8" mark for bread, breakfast cereals, granola-based snack bars, muffins, cookies, wheat-based snack foods in bar form and crackers, that such closely related goods emanate from, or are otherwise sponsored by or affiliated with, the same source.

Decision: The opposition is sustained and registration to applicant is refused.

R. F. Cissel

G. D. Hohein

C. E. Walters

Opposition No. 105,165

Administrative Trademark Judges,
Trademark Trial and Appeal Board